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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,882	02/09/2001	Jacques Benkoski	MDS-P009	9016
7590	01/17/2006		EXAMINER	
BURT MAGEN, ESQ BIERRA MAGEN MARCUS HAMON & DENIRO L.L.P. 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			JANVIER, JEAN D	
		ART UNIT	PAPER NUMBER	3622

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/780,882	BENKOSKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 26-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: ____.                                    |

### **Response To Applicant's Arguments**

In response to Applicant's remarks, the Examiner will consider claims 26-32 for examination.

**Furthermore, the Applicant is encouraged to contact the Examiner to discuss potential claim language that may be used to amend the claims, thereby putting the claims in better condition for examination, while eliminating certain ambiguity therein.**

The following is an example of a claim language that may be used in amending independent claim 26.

A method for monitoring the use of a computer-aided-design tool (CAD) to produce a design project or an output data file and enforcing a contract associated with the use of the computer-aided-design in producing the output data file, comprising the following steps:

Entering into a computer system as part of the contract criteria for making a first payment and a second payment representing a purchase price related to the CAD tool;

Entering a trigger condition or a criterion from the contract into the computer system specifying when the second payment is to be made by a designer or buyer to the CAD company for purchasing the CAD tool;

Receiving the computer-aided-design tool (CAD) by the designer from the CAD company, wherein the designer uses the CAD to produce the output data file;

Making the first payment by the designer to the CAD company upon receipt of the CAD tool;

Creating the design project or output data file by the designer using the CAD tool;

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Adding a watermark to the design project or output data file to identify the output data file as having been produced or created with the CAD tool, wherein the watermark consists of a naming convention, **non-functional data**, a spacing convention, an ordering convention and **other non-functional elements**;

Determining whether the CAD tool was used in the creation of an output data file or design project by detecting the presence of a watermark in the created output data file or design project;

Generating a request for the second payment to the designer upon determining that the created output data file was produced using the CAD tool upon detecting the presence of the watermark inserted therein;

Receiving the second payment from the designer in accordance with the trigger condition set forth in the contract

### **Conclusion**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

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Jean D. Janvier

JDJ

Patent Examiner

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JEAN D. JANVIER  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Jean D. Janvier". Below the signature, the text "PRIMARY EXAMINER" is printed in capital letters.